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09/885,970	06/21/2001	Bruce A. Fogelson	7272-80216	5291
24628	7590	05/18/2007	EXAMINER	
WELSH & KATZ, LTD 120 S RIVERSIDE PLAZA 22ND FLOOR CHICAGO, IL 60606			JANVIER, JEAN D	
			ART UNIT	PAPER NUMBER
			3622	
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			05/18/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

09/885,970

Applicant(s)

FOGELSON, BRUCE A.

Examiner

Jean Janvier

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-58 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-58 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_.

Art Unit: 3622

### **Response To Applicant's Arguments**

In general, Applicant's arguments are moot in view of new grounds of rejection since the arguments are based on the claims as currently amended.

Furthermore, regarding the 103(a) Rejection, it is unclear whether or not the Applicant is of the opinion that incorporating a "firewall" into a computer system is not notoriously well known. In any event, the use of a "firewall" is well documented and easily identifiable in the art and thus, no evidence is required here to demonstrate or support something that the Applicant should be familiar with.

Additionally, regarding the "**Claim Objections**", the portion cited by the Applicant is correct. However, the Examiner is not certain that "may not" sometimes mean "may" as the Applicant so concluded. Having said that, however, the Examiner herein withdraws the said "Claim Rejections" and re-introduces it under "General Comments".

Therefore, the Applicant's request for allowance or withdrawal of the last Office Action has been fully considered and respectfully denied in view of the foregoing response since the Applicant's arguments as herein presented are not plausible and thus, the current **Office Action has been made Final.**

### **DETAILED ACTION**

#### ***Specification***

#### ***Claim Status***

Claims 1-58 are currently pending in the Application.

#### **General Comments**

Concerning claims 4 and 32, although the advertiser may **indicate whether the advertisement shall be printed in a physical ad-book, however, as per the specification, where advertisement may be viewed from user terminals 2, 4, ad-books may not be printed in physical form**. In other words, even if advertiser may indicate that his ads may be printed in a physical ad-book, the system is operable, however, to disable this function, especially since the advertisements are primarily viewed online or over the Internet. Thus, this indication is not necessary or useful since it cannot be enforced even if the advertiser wanted to have the advertisement printed in a physical ad-book and since the ad-book cannot be printed in a physical form (see paragraph [0036] and lines 13 and 14 of the specification).

Here, using the “ad book”, having inserted therein ads placed by advertisers or supporters, as a vehicle to raise funds on behalf of charities is a non-functional descriptive material that does not impact the content of the ads per se and the manner in which the ads are created and placed into the “ad book”. The same “ad book” could be used to raise money for any other project. In other words, the purpose or the specific use of the “ad book”, having ads inserted therein, does not immediately impact the functionality of the system.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 26, 27, 28, 29, 33, 45-49, 50 and 58 (including their dependent claims) are rejected under 35 USC 112(2) as being indefinite for including “and/or”. It is rather unclear whether the Applicant meant to refer to - -and- - or - -or- -. For Examination purpose, the Examiner assumes that the Applicant meant to refer to - -or- -.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-9, 12-15, 16-27, 28-37, 40-49 and 50-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rothstein, US PUB, 2002/0188532A1.**

As per claims 1-9, 12-15, 16-27, 28-37, 40-49 and 50-58, Rothstein discloses an apparatus and method for advertising in electronic documents (ad books). According to one implementation, the method includes receiving an electronic book from a publisher (organization), receiving one or more electronic ads from one advertiser (supporter), inserting the electronic ads into the electronic book to create an enhanced electronic book (ad book) and sending the enhanced electronic book to a customer for viewing or reading the advertisements included in the ad book (See abstract; figs. 1-5; paragraph [0006]).

In general, publishers have begun to provide more substantial electronic documents, which are referred to herein as "electronic books." An example of an electronic book is a book that has been converted to electronic form for download and display. Electronic books have been developed for PDAs such as the Palm-Pilot and Windows CE devices. One supplier of such

Art Unit: 3622

books is Peanut Press (www.peanutpress.com). See paragraphs [0004] and [0002], [0003] and [0005].

Rothstein discloses, in one embodiment, that the electronic ads are received from one or more advertisers over a network. When an enhanced electronic ad book, containing electronic ads associated with one advertiser, is sent to a customer via a hyperlink, a debit entry is created in the advertiser's account. Subsequently, the advertiser is billed according to the entries in the advertiser's account (charging the advertisers a fee for inserting the ads in the ad book and for providing the ads via the ad book to the customer (providing the ad book to the user). See paragraphs [0008], [0007] and [0009].

Rothstein further discloses, in another aspect, that the location within the electronic book (ad book) for insertion of an ad is determined according to one or more keywords associated with the electronic ad. The keywords can be supplied by the **advertiser** **that** provided the ad. Pages within the electronic book can be scored according to the keywords and a suitable location is selected according to the score. Further, the electronic ads are inserted within a structured electronic document, such as a sound file or video file. See paragraphs [0010]-[0013].

Art Unit: 3622

Please consider the entire disclosure.

As per claims 1, 28, 29 and 50, although in Rothstein's, the "ad book", having one or more ads inserted therein, can be used for any purpose, however, Rothstein does not expressly disclose using by an organization (publisher) the "ad book", having inserted therein one or more ads placed by advertisers or supporters, as a fund raising vehicle.

However, it is common practice in the art for an organization or a third party (merchant or a clearinghouse) to raise funds on behalf of a non-profit or charitable organization using a plurality of well-known methods (see the Burke's Patent cited in the conclusion section). For example, "Street News" is a local newspaper published by an organization in New York City on behalf of the Homeless. The organization solicits and receives ads from advertisers or supporters, supporting the Homeless cause, and the advertisers' messages are placed or displayed in the newspaper that is distributed and sold to the public at large and the advertisers or supported are billed for placing their ads in the newspaper. The revenue collected from the sale of the newspapers and advertising space to the advertisers is used, minus the overhead cost, to help provide food, housing and so on to the NYC Homeless.

In addition, an organization or individual selling "Special" greeting cards to raise funds for the needed solicits ads from advertisers or supporters willing to place ads for a fee in the "Special" greeting cards before they are being printed and sold to the public or supporters, wherein the revenue collected from the sale of the greeting cards and advertising space to the advertisers is used, minus the overhead cost, to help the needed.

Finally, using the "ad book", having inserted therein ads placed by advertisers or supporters, as a vehicle to raise funds on behalf of charities is a non-functional descriptive

Art Unit: 3622

material that does not impact the content of the ads per se and the manner in which the ads are created and placed into the “ad book”. The same “ad book” could be used to raise money for any other project. In other words, the purpose or the specific use of the “ad book”, having ads inserted therein, does not immediately impact the functionality of the system.

“Official Notice”

Therefore, an ordinary skilled artisan, using or implementing the system of Rothstein, would have been motivated at the time of the invention to incorporate the above disclosure (“Official Notice”) into the system of Rothstein so as use the “ad book” teachings for any purpose including, but not limited to, raising funds on behalf of charities, wherein an organization solicits and receives ads from advertisers or supporters, supporting a specific cause or charity, and the advertisers’ messages are placed or displayed in the electronic “ad book” or physical “ad book”, such as newspapers, greeting cards and so on, distributed and sold to the public at large and the advertisers or supported are billed for placing their ads in the “ad book”, wherein the revenue collected from the sale of the newspapers and advertising space to the advertisers is used, minus the overhead cost, to help provide food, housing/shelter and so on to the Homeless, poor and the needed, thereby providing an easy tool/means or vehicle used by organizations to raise funds on behalf of charities, wherein the collected funds, minus the overhead cost, are used to continue to provide the necessary and indispensable assistance to the poor and needed, while featuring the company associated with the “ad book” as a company that cares for the poor and the needed, which in the end helps improve the company image through a good PR (Public Relations).



Art Unit: 3622

As per claims 10-11 and 38-39, although Rothstein silently or implicitly supports at least the use of login names and passwords by at least the publishers and the advertisers to upload electronic books and advertisements data respectively onto the web server 220 of fig. 2, however, Rothstein does not explicitly disclose that the web server comprises **a firewall for maintaining security**.

However, it is common practice in the art of computer technology to use or install a firewall module (software) on a file server or local terminal to prevent unauthorized users from accessing the server or terminal, thereby securing or protecting data stored on the server or terminal.

“Official Notice”.

Therefore, an ordinary skilled artisan, using or implementing the system of Rothstein, would have been motivated at the time of the invention to incorporate the above disclosure (“Official Notice”) into the system of Rothstein so as to install a firewall module on the web server 220 to thereby protect the data, such as advertisement data and electronic book data, stored on the server by preventing unauthorized users from accessing the server, while providing a greater layer of security at the server side, as would have understood an ordinary skilled artisan.

### **Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US PUB 2002/0162106 to Pickover discloses a system for choosing an advertisement based on the last media content monitored just before the break. Alternatively, the content of

Art Unit: 3622

various past selections may be monitored and acted upon in selecting advertising content. In yet another embodiment the system may be proactive and accept input from the client. For example, if the user selects the "change channel" button on a remote TV control, the TV may ask, "Would you like to hear an ad on cars?" or "Press 1 for an ad on cars; press 2 for an ad on books." Each of the above choices would be facilitated by an intelligent agent as being part of the system. In the absence of any other guidance, with or without the involvement of an intelligent agent, the advertisement to be presented may be determined by the queuing sequence of advertisements in the storage element (See abstract and [0010]).

**USP 6, 112, 191 to Burke** discloses an "open" POS network having a spending /saving system consisting of registered subscribers/payors, who tender payments exceeding the balance due or the transaction values during transactions at registered retailers' POS terminals, wherein the differences or excess funds between the received payments and the transaction values or retail prices are calculated or computed by the POS terminals or ECRs and deposited in an internal payor's or consumer's account maintained by merchants or retailers MC, related to the POS terminals, who in turn transfer the excess payments or collected differences to a single clearinghouse computer CCC, for further processing, on behalf of an identified payor or customer who identifies himself via a subscriber card swiped at the POS terminal or entering an account code therein. Further, the system allows each subscriber or SP the ability to make multiple deposits in various cross country locations at related and unrelated merchants' POS terminals, wherein the subscriber or payor can contribute as little as **a penny** in a transaction in 24 hour period. The storing of the differences or excess payments corresponding to the payor into the merchants' system databases or remote terminals can be conducted online or offline. At

Art Unit: 3622

the completion of a specified period (periodically or weekly or daily) or when a certain threshold amount (like \$50.00) is reached, the total off-line transaction file, associated with the identified customer, stored in the merchant terminal internal databases is then batched online from each individual merchant's local database to the clearinghouse central computer CCC, **which transmits the collected differences or pennies via an EFT system to a PC related to at least one payor's selected provider account or PA, which can be banks, insurance companies, security firms, for deposits or savings and investments** and the payor or the registered or enrolled customer can determine how to use the savings. **Moreover, the PA, such a bank, a security firm or any other investment firm, will manage the subscriber's or SP's account in accordance with the subscriber's instructions.** The POS terminals at the merchants transfer the subscribers' excess payments or the differences or change due to the clearinghouse central computer or CCC in real-time via communication link CS. The subscribers can specify or have full control over the amount of excess payments they want to contribute or deposit into their accounts at one or more PAs, such banks, security firms, insurance companies or other investment entities (See abstract; col. 2: 45 to col. 3: 14; col. 3: 14-30; col. 3: 31-35; col. 3: 49-64; col. 4: 46-62; col. 4: 63 to col. 5: 40; col. 9: 1-15).

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after

Art Unit: 3622

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication from the Examiner should be directed to Jean D. Janvier, whose telephone number is (571) 272-6719. The aforementioned can normally be reached Monday-Thursday from 10:00AM to 6:00 PM EST. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. Eric W. Stamber, can be reached at (571) 272- 6724.

Non-Official- 571-273-6719.

Official Draft : 571-273-8300

Re. 06/24/06

05/14/07

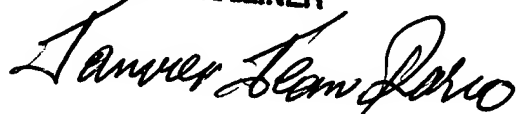
**JDJ**

**Jean D. Janvier**

**Patent Examiner**

Art Unit 3622

**JEAN D. JANVIER  
PRIMARY EXAMINER**

A handwritten signature in black ink, appearing to read "Janvier Jean D.", written over the printed name and title.